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OFFICE OF PETITIONS

In re Application of :
Tilling et al. :
Application No. 10/727,279 : DECISION DISMISSING
Filed: 3 December, 2003 : PETITION
Atty Docket No. 120303 :

This is a decision in reference to the petition filed on 8 October, 2004, which is treated as a petition under 37 CFR 1.53 requesting that the above-identified application be accorded a filing date of 3 December, 2003, with Figures 47 and 48 described in the specification as a part of the original disclosure.

The petition is dismissed.

On 3 December, 2003, the application was filed.

On 15 September, 2004, the Office of Initial Patent Examination (OIPE) mailed a Notice of Omitted Item(s) in a Nonprovisional Application stating that the application had been accorded a filing date of 3 December, 2003, but that Figures 47 and 48 described in the specification appeared to have been omitted from the application.

In response, on 8 October, 2004, the present petition was filed. Petitioners argue that Figures 47 and 48 were among the application papers filed on 3 December, 2003, but were lost after receipt in the USPTO. Specifically, petitioners assert that a set of "auxillary" drawings were filed along with the application drawings, and that the USPTO did not process the proper set of drawings.

At the outset, a review of the application papers filed on 3 December, 2003, reveals that only one set of drawings was received and processed by the USPTO. No Figures 47 and 48 were filed on 3 December, 2003, since no such figures were among the application papers received on that date. If petitioners have an itemized stamped postcard acknowledging receipt of Figures 47 and 48 in the USPTO on 3 December, 2003, petitioners should submit that evidence, along with a copy of the omitted figures, with a renewed petition.

It is noted that the USPTO has a long-established and well publicized practice for *prima facie* establishing the date of receipt of correspondence that has either been mailed or otherwise delivered to the PTO, and is asserted to have been subsequently misplaced: the itemized postcard receipt practice of MPEP 503.¹ This practice requires that any paper(s) for which a receipt is desired be filed in the USPTO with a self-addressed postcard identifying the paper(s). A postcard receipt which itemizes and properly identifies the paper(s) which is being filed serves as *prima facie* evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO. However, due to the absence in the record of a postcard receipt itemized with respect to the specification that bears a USPTO date stamp of 3 December, 2003, showing that Figures 47 and 48 were received in the USPTO on 3 December, 2003, the application cannot be accorded a filing date of 3 December, 2003, with Figures 47 and 48 as a part of the original disclosure.

It is noted that the first line of the specification in the present application incorporates by reference provisional Application No. 60/432,162.

MPEP 201.06(c) states that:

. . . an applicant may incorporate by reference the prior application by including, in the application-as-filed, a statement that such specifically enumerated prior application or applications are "hereby incorporated herein by reference." The statement may appear in the specification or in the application transmittal letter. The inclusion of this incorporation by reference of the prior application(s) will permit an applicant to amend the

¹ The public was afforded a "reminder" of the then extent post card receipt practice at 857 Off. Gaz. Pat. Off. 667 (O.G.) (Nov. 21, 1968). This specific notice is usually repeated annually, in a January "Consolidated Listing" section of the O.G. that contains important O.G. notices of continuing relevance.

continuing application to include any subject matter in such prior application(s), without the need for a petition.
(emphasis supplied)

Obviously, in view of the incorporation by reference of the prior application, Figures 47 and 48 described in the specification are not new matter if they were a part of the disclosure of the prior application.

Petitioner should file Figures 47 and 48 as a preliminary amendment. If Figures 47 and 48 are filed as a preliminary amendment, it will be reviewed by the examiner for new matter.

The application will be processed using only the application papers present on filing.

As the Notice mailed on 15 September, 2004, correctly stated that Figures 47 and 48 appeared to have been omitted, the petition was not necessitated by an error on the part of the Office. Therefore, the petition fee will not be refunded.

The application is being returned to Initial Patent Examination Division for further processing with a filing date of 3 December, 2003, using only the application papers filed on that date.

Telephone inquiries concerning this matter may be directed to the undersigned at (571)272-3231.



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